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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,056	10/10/2001	Michihiro Izumi	35.C15861	5038

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EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,056

Applicant(s)

IZUMI ET AL.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed 2/6/2002 (paper no. 3) has been considered.

Drawings

3. The drawings are objected to because S516 as shown in figure 5 should be --NOTIFY CPU 201 OF FACSIMILE SENDING-- instead of "NOTIFY CPU 201 OF E_MAILING" in accordance with the specification, page 15, lines 10-12. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the key representing simultaneous sending of facsimile and the electronic mail must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, it is unclear how means for notifying the destination in case of sending the electronic mail to the electronic mail address because the claimed language merely states "means for notifying the destination having the facsimile number registered for the same abbreviated number as that for which the electronic mail address has been registered", which fails to define means for notifying the destination utilizing the facsimile number registered for the same abbreviated number as that for which the electronic mail address has been registered for sending a facsimile document to the destination indicating the electronic mail has been sent.

Claims 9 and 16 are also rejected because of containing the same claimed limitation as defined in claim 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 5-8, 12-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto et al. (JP 10042068 A hereinafter Yasumoto) in view of Idehara (US PAT. 6,438,605).

Regarding claim 1, Yasumoto discloses a communication terminal equipment as shown in figure 1 including means for connection to a public communication line (11), a scanner (2) for reading an image, means for converting the image read by the scanner to have a predetermined format (22, figure 2), means for executing a sending process (24, figure 2) to a server connected to the public communication line in a case when the communication terminal equipment sends the converted image as an electronic mail to the Internet comprising means for registering a

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facsimile number of a destination and an electronic mail address of a destination to an abbreviation dial key, i.e., one easy step key, means for executing the facsimile sending of the read image to the registered facsimile number when the facsimile communication is judged, and means for executing the electronic mail sending of the read image to the registered electronic mail address when the electronic mail communication is judged (abstract). Yasumoto differs from the claimed invention in not specifically teaching a key representing the facsimile sending is depressed pursuant to depression of said abbreviation dial key for executing facsimile sending and a key representing the electronic mail sending is depressed pursuant to depression of said abbreviation dial key for executing electronic mail sending. However, Idehara teaches communication equipment including operating mode selection buttons, i.e., a key representing the facsimile sending (31a, figure 2) and a key representing the electronic mail (31e, figure 2), on an operation panel for selecting between e-mail mode and a facsimile mode col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19) in order to make user friendly. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Yasumoto in having the key representing the facsimile sending is depressed pursuant to depression of said abbreviation dial key for executing facsimile sending and the key representing the electronic mail sending is depressed pursuant to depression of said abbreviation dial key for executing electronic mail sending, as per teaching of Idehara, it makes user friendly for selecting between the facsimile mode and the e-mail mode.

Regarding claim 5, Idehara teaches means for registering input data as the electronic mail address in a case where said key representing the electronic mail sending is depressed pursuant to input of the electronic address and means for registering input data as the facsimile number in

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a case where said key representing the facsimile sending is depressed pursuant to input of the facsimile data in the registering process for the abbreviation number (col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19).

Regarding claim 6, Idehara teaches means for registering input data as the electronic mail address in a case where a specific symbol, i.e., @, used in the electronic mail address is included in the input data in the registering process for the abbreviation number (col. 4 lines 3-32 and col. 10 lines 17-19).

Regarding claim 7, Idehara discloses the communication equipment including a first CPU (11, figure 1) for detecting that said key representing the electronic mail sending is depressed, means for notifying a second CPU (18, figure 1) that the first CPU executed the detection, means for forming electronic mail data when the second CPU receives the notification and means for executing the data sending process from said second CPU to the public communication line (col. 3 lines 49-57 and col. 5 lines 9-48).

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 12, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 7.

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Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 21, the limitations of the claim are rejected as the same reasons set forth in claim 7.

9. Claims 2, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto et al. (JP 10042068 A hereinafter Yasumoto) in view of Idehara (US PAT. 6,438,605) as applied in claims above, and further in view of Ishibashi et al. (EP 812100 A2 hereinafter Ishibashi).

Regarding claim 2, the combination of Yasumoto and Idehara differs from the claimed invention in not specifically teaching means for notifying the destination by using the facsimile number registered for the same abbreviation number as that for which the electronic mail address has been registered to send a notification to the destination in case of sending the electronic mail to the electronic mail address. However, Ishibashi teaches a communication terminal apparatus capable of informing a receiving side of with a transmission of an electronic mail in case of sending the electronic mail to the electronic mail address (page 2 lines 42-59 and page 4 line 40 through page 6 line 29) in order to quickly notify the receiving side that electronic mail has been transmitted. Therefore, it would have been obvious to a person of ordinary skill in the art at the

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time the invention was made to modify the combination of Yasumoto and Idehara in notifying the destination by using the facsimile number registered for the same abbreviation number as that for which the electronic mail address has been registered to send a notification to the destination in case of sending the electronic mail to the electronic mail address, as per teaching of ishibashi, in order to quickly notify the receiving side that electronic mail has been transmitted.

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 2.

10. Claims 3-4, 10-11 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto et al. (JP 10042068 A hereinafter Yasumoto) in view of Idehara (US PAT. 6,438,605) as applied in claims above, and further in view of Yazaki (JP 10126600 A).

Regarding claim 3, Yasumoto discloses the communication terminal equipment for executing the facsimile sending of the read image to the registered facsimile number by using a first communication channel (L2, figure 1) and executes the electronic mail sending of the read image to the registered electronic mail address by using a second communication channel (L1) by depression of the key corresponding to the abbreviation number (abstract) and Idehara teaches to depress said key representing the facsimile sending and said key representing the electronic mail sending for executing facsimile sending and electronic mail sending col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19). The combination of Yasumoto and Idehara differs from the claimed invention in not specifically teaching to simultaneously executing plural

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communications. However, Yazaki teaches a communication terminal equipment to allow an adapted data transmission means to send data by registering a logic address of a transmission destination and a data transmission means in cross reference so that the data transmission means corresponding to the selected logic address sends data to each destination when an operation section select the logic address of the destination, thereby data can be sent automatically to each physical address (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Yasumoto and Idehara in simultaneously executing plural communications, as per teaching of Yazaki, thereby data can be sent automatically to each physical address.

Regarding claim 4, although neither the combination of Yasumoto and Idehara nor Yazaki specifically discloses a key representing simultaneously sending of the facsimile and the electronic mail, it is well known in the art of combining said key representing the facsimile sending and said key representing the electronic mail sending as one key for simplifying operation structure so that plural communications, i.e., facsimile sending and electronic mail sending, can be simultaneous performed when a key representing simultaneously sending of the facsimile and the electronic mail is depressed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Yasumoto, Idehara and Yazaki in having the key representing simultaneously sending of the facsimile and the electronic mail in order to simplify operation structure.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 3.

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Regarding claim 11, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 18, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maeda (US PAT. 6,437,873) discloses an Internet facsimile apparatus having an Internet fax function capable of transmission with an optimum Internet fax (abstract). Okada (US PAT. 6,101,244) discloses a communication terminal device for sending data by means for electronic mail and facsimile (abstract). Toyoda (US PAT. 5,881,233) discloses a facsimile mail apparatus capable of selecting facsimile mode and electronic mail modem by operating mode selection button on an operational panel (figure 24, and col. 20 line 8 through col.21 line 67).

12. Any response to this action should be mailed to:

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Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

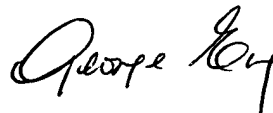
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Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



George Eng

Examiner

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